UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/535,877	03/28/2000	Terence Boyle	CITI0139	5079

27510   7590   04/04/2003

KILPATRICK STOCKTON LLP
607 14TH STREET, N.W.
SUITE 900
WASHINGTON, DC 20005

EXAMINER
CHENCINSKI, SIEGFRIED E

ART UNIT	PAPER NUMBER
3628	

DATE MAILED: 04/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _28 March 2000_ .

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1-51_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1-51_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

    If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

        1.☐ Certified copies of the priority documents have been received.

        2.☐ Certified copies of the priority documents have been received in Application No. _____ .

        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

    a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _5_ .

4)☐ Interview Summary (PTO-413) Paper No(s). _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: .

DETAILED ACTION

Claim Rejections - 35 USC § 112

1.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly
> claiming the subject matter which the applicant regards as his invention.

Claims 42, 43, 44, 50 & 51 are rejected under 35 U.S.C. 112, second paragraph, as

being indefinite for failing to particularly point out and distinctly claim the subject matter

which applicant regards as the invention due to a failure to specify which of the

preceding claims it applies to. The rejected claims do not have proper antecedent basis,

e.g. "the system, the "means". This appears to be a typographical error. For the

following rejections, claims 42, 44 and 50 are treated as if depending on claim 35.

Claim Rejections - 35 USC § 103

2.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

3.   **Claims 1, 11-20, 22, 27-35, 42-44, 47, 50 & 51 are rejected** under 35 U.S.C.

103(a) as being unpatentable over Dunn (US Patent 5,134,564) in view of Hawkins (US

Patent 6,247,000).

Re. Claims 1 & 35, Dunn discloses a method and system means for reconciliation of account records, comprising:

- receiving first and second account records (Abstract);
- automatically comparing the account records according to predefined matching rules to identify one of matched and unmatched first and second account records (Abstract);

Dunn does not disclose

- if unmatched account records are identified in the comparison, allowing a manual match of the unmatched account records.

However, Hawkins discloses a method and system for reconciliation of account records, comprising, if unmatched account records are identified in the comparison, a method and means for allowing a manual match of the unmatched account records (Col. 32, lines 41-51).

It would have been obvious for an ordinary practitioner of the art at the time of applicant's invention to combine the disclosure of Dunn with that of Hawkins in order to develop an efficient automated system for reconciling account records.

Re. Claims 11-20, 22, 27-34, 42-44, 47, 50 & 51, Dunn does not explicitly disclose a method and system means

- **Re. Claim 11 & 42,** of claim 1 & 35, wherein automatically comparing the account records further comprises uploading the account records to a database;
- **Re. Claim 12,** of claim 11, wherein uploading the account records further comprises formatting the account records;
- **Re. Claim 13,** the method of claim 12, wherein uploading the account records further comprises parsing the account records;
- **Re. Claim 14,** the method of claim 13, wherein uploading the account records further comprises validating the account records;
- **Re. Claims 15 & 43,** the method of claim 11, wherein uploading the account records further comprises uploading the account records according to a predefined schedule.

- **Re. Claims 16 & 44,** the method of claim 1, wherein automatically comparing the account records further comprises predefining the matching rules;

- **Re. Claim 17,** the method of claim 16, wherein predefining the matching rules further comprises predefining available match groups for a fund manager and a custodian;

- **Re. Claim 18,** the method of claim 16, wherein predefining the matching rules further comprises predefining the matching rules for the account records for at least one of a position and a transaction;

- **Re. Claim 19,** the method of claim 18, wherein predefining the matching rules further comprises predefining substantially similar matching rules for the account records for the position and transaction;

- **Re. Claim 20,** the method of claim 18, wherein predefining the matching rules further comprises predefining different matching rules for the account records for the position and transaction;

- **Re. Claim 22,** the method of claim 16, wherein predefining the matching rules further comprises predefining the matching rules for at least one item of account data selected from a group of account data items consisting of account number, security identification, units, unit cost, total cost, unit price, and total market value;

- **Re. Claims 27 & 47,** the method of claim 1 and system means of claim 35, wherein allowing the manual match further comprises generating a report of the comparison identifying the unmatched account records;

- **Re. Claim 28,** the method of claim 27, wherein generating the report further comprises generating an historical report of the comparison;

- **Re. Claim 29,** the method of claim 27, wherein generating the report further comprises displaying the report for a user;

- **Re. Claims 30,** the method of claim 29, wherein displaying the report further comprises displaying the unmatched first and second account records simultaneously for the user;

- **Re. Claim 31,** the method of claim 29, wherein displaying the report further comprises prompting the user for entry of the manual match;

- **Re. Claims 32 & 50,** the method and system means of claim 1, wherein allowing the manual match further comprises identifying a reason for the manual match (Col. 34, lines 45-55);

- **Re. Claim 33,** the method of claim 32, wherein identifying the reason further comprises storing a record of the reason for the manual match;

- **Re. Claims 34 & 51,** the method of claim 33 and the system means of claim 50, wherein storing the record further comprises allowing a retrieval of the record of the reason for the manual match.

However, Hawkins discloses a method and system means

- **Re. Claim 11 & 42,** of claim 1 & 35, wherein automatically comparing the account records further comprises uploading the account records to a database (Col. 2, lines 30-37);

- **Re. Claim 12,** of claim 11, wherein uploading the account records further comprises formatting the account records (Inherent);

- **Re. Claim 13,** the method of claim 12, wherein uploading the account records further comprises parsing the account records (Inherent in Dunn and Hawkins);

- **Re. Claim 14,** the method of claim 13, wherein uploading the account records further comprises validating the account records (Inherent);

- **Re. Claims 15 & 43,** the method of claim 11, wherein uploading the account records further comprises uploading the account records according to a predefined schedule (Inherent).

- **Re. Claims 16 & 44,** the method of claim 1, wherein automatically comparing the account records further comprises predefining the matching rules (Col. 23, line 11);

- **Re. Claim 17,** the method of claim 16, wherein predefining the matching rules further comprises predefining available match groups for a fund manager and a custodian (Col. 8, line 17-19);

- **Re. Claim 18,** the method of claim 16, wherein predefining the matching rules further comprises predefining the matching rules for the account records for at least one of a position and a transaction (an inherent requirement of matching);

- **Re. Claim 19,** the method of claim 18, wherein predefining the matching rules further comprises predefining substantially similar matching rules for the account records for the position and transaction (Inherent to matching);

- **Re. Claim 20,** the method of claim 18, wherein predefining the matching rules further comprises predefining different matching rules for the account records for the position and transaction (Some data elements of account record data in a securities position is inherently different from account record data in a transactions record);

- **Re. Claim 22,** the method of claim 16, wherein predefining the matching rules further comprises predefining the matching rules for at least one item of account data selected from a group of account data items consisting of account number, security identification, units, unit cost, total cost, unit price, and total market value (Obvious and inherent to the nature of security transaction and position data);

- **Re. Claims 27 & 47,** the method of claim 1 and system means of claim 35, wherein allowing the manual match further comprises generating a report of the comparison identifying the unmatched account records (Inherent in Dunn and Hawkins);

- **Re. Claim 28,** the method of claim 27, wherein generating the report further comprises generating an historical report of the comparison (Inherent);

- **Re. Claim 29,** the method of claim 27, wherein generating the report further comprises displaying the report for a user (Col. 8, lines 48-56);

- **Re. Claims 30,** the method of claim 29, wherein displaying the report further comprises displaying the unmatched first and second account records simultaneously for the user (An inherent feature available in Windows technology);

- **Re. Claim 31,** the method of claim 29, wherein displaying the report further comprises prompting the user for entry of the manual match (Inherent to applicant's chosen computer technology);

- **Re. Claims 32 & 50,** the method and system means of claim 1, wherein allowing the manual match further comprises identifying a reason for the manual match (Col. 33, lines 45-47; It is also obvious that records which do not satisfy automated matching criteria will need to be manually matched);

- **Re. Claim 33,** the method of claim 32, wherein identifying the reason further comprises storing a record of the reason for the manual match (An inherent feature of computer systems, including the PC workstations and Windows operating systems chosen by applicant);

- **Re. Claims 34 & 51,** the method of claim 33 and the system means of claim 50, wherein storing the record further comprises allowing a retrieval of the record of the reason for the manual match (An inherent feature of computer systems, including the PC workstations and Windows operating systems chosen by applicant).

It would have been obvious for an ordinary practitioner of the art at the time of applicant's invention to combine the disclosures of Dunn with that of Hawkins, and to add inherently obvious elements to the disclosures, such as rules for manual matching, and adoption of various tools and features available in the Microsoft and MacIntosh Windows technologies, in order to develop an efficient automated system for reconciling account records.

4.   **Claims 2-10, 24-26, 36-41, 45-46 & 48-49 are rejected** under 35 U.S.C. 103(a) as being unpatentable over Dunn in view of Hawkins and further in view of Harris (US Patent 5,517,406).

The disclosures of Dunn and Hawkins are cited above.

Dunn and Hawkins do not disclose

- **Re. Claims 2,** the method of claim 1, wherein receiving the account records further comprises receiving the first and second account records for one of a position and a transaction;

- **Re. Claim 3,** the method of claim 2, wherein receiving the account records for the position further comprises receiving the first and second account records for one of a securities position and a cash position;

- **Re. Claim 4,** the method of claim 2, wherein receiving the account records for the transaction further comprises receiving the first and second account records for one of a securities transaction and cash transaction;

- **Re. Claims 5 & 36,** the method of claim 1 and system means of claim 35, wherein receiving the account records further comprises receiving the first account record from one of a fund manager and a custodian and receiving the second account record from the other of the fund manager and the custodian);

- **Re. Claims 6 & 37,** the method of claim 5 and systems means of claim 36, wherein receiving the account record from the fund manager further comprises receiving the account record electronically from an internal portfolio tracking system of the fund manager;

- **Re. Claims 7 & 38,** the method of claim 5 and systems means of claim 36, wherein receiving the account record from the custodian further comprises receiving the account record electronically via an interface to a custody network of the custodian;

- **Re. Claims 8 & 39,** the method of claim 7 and systems means of claim 38, wherein receiving the account record electronically via the interface to the custody network of the custodian further comprises receiving the account record electronically via a proprietary financial network;

- **Re. Claims 9 & 40,** the method of claim 1 and systems means of claim 35, wherein receiving the account records further comprises receiving the account records by a database;

- **Re. Claims 10 & 41,** the method of claim 9 and the systems means of claim 40, wherein receiving the account records by the database further comprises receiving the account records by a service bureau database.

- **Re. Claims 24 & 45,** the method of claim 1 and the systems means of claim 35, wherein automatically comparing the account records further comprises generating a report of the comparison);

- **Re. Claims** 25, 46 & 48, the method of claim 24 and the systems means of claim 45 & 47, wherein generating the report further comprises displaying the report for a user on a terminal;

- Re. Claims 26, the method of claim 24, wherein generating the report further comprises allowing a user to download the report in a file.

- Re. Claim 49, the system of claim 48, wherein the means for generating the report further comprises means for displaying the unmatched first and second account records simultaneously for the user on a consolidated display at the terminal.

However, Harris discloses

- **Re. Claims 2,** the method of claim 1, wherein receiving the account records further comprises receiving the first and second account records for one of a position and a transaction (Harris, 5,517,406, Title, Col. 2, line 45; Col. 3, lines 5-10);

- **Re. Claim 3,** the method of claim 2, wherein receiving the account records for the position further comprises receiving the first and second account records for one of a securities position and a cash position (Re. Securities: Col. 6, lines 5-8; Re. Cash: It is well known that Cash is a component of most investor accounts);

- **Re. Claim 4,** the method of claim 2, wherein receiving the account records for the transaction further comprises receiving the first and second account records for one of a securities transaction and cash transaction (Re. Securities Transactions: Col. 6, line 7; Col. 5, lines 46-52; Re. Cash: It is well known that Cash is a component of most investor accounts);

- **Re. Claims 5 & 36,** the method of claim 1 and system means of claim 35, wherein receiving the account records further comprises receiving the first account record from one of a fund manager and a custodian and receiving the

second account record from the other of the fund manager and the custodian (Col. 5, line 44 – Col. 6, line 16);

- **Re. Claims 6 & 37,** the method of claim 5 and systems means of claim 36, wherein receiving the account record from the fund manager further comprises receiving the account record electronically from an internal portfolio tracking system of the fund manager (Col. 5, line 44 – Col. 6, line 16);

- **Re. Claims 7 & 38,** the method of claim 5 and systems means of claim 36, wherein receiving the account record from the custodian further comprises receiving the account record electronically via an interface to a custody network of the custodian (Col. 5 line 62 – Col. 6, line 16);

- **Re. Claims 8 & 39,** the method of claim 7 and systems means of claim 38, wherein receiving the account record electronically via the interface to the custody network of the custodian further comprises receiving the account record electronically via a proprietary financial network (Col. 5 line 62 – Col. 6, line 16);

- **Re. Claims 9 & 40,** the method of claim 1 and systems means of claim 35, wherein receiving the account records further comprises receiving the account records by a database (Hawkins, Col. 3, lines 26-34; Harris, Inherent);

- **Re. Claims 10 & 41,** the method of claim 9 and the systems means of claim 40, wherein receiving the account records by the database further comprises receiving the account records by a service bureau database (Hawkins, Col. 2, lines 30-37; Harris, Abstract).

- **Re. Claims 24 & 45,** the method of claim 1 and the systems means of claim 35, wherein automatically comparing the account records further comprises generating a report of the comparison (Col. 8, Line 37);

- **Re. Claims** 25, 46 & 48, the method of claim 24 and the systems means of claim 45 & 47, wherein generating the report further comprises displaying the report for a user on a terminal (Hawkins, Col. 8, lines 48-56);

- **Re. Claim 26,** the method of claim 24, wherein generating the report further comprises allowing a user to download the report in a file (Col. 14, lines 11-16);

- **Re. Claim 49**, the system of claim 48, wherein the means for generating the report further comprises means for displaying the unmatched first and second account records simultaneously for the user on a consolidated display at the terminal (Inherent to applicant's chosen computer technology).

It would have been obvious for an ordinary practitioner of the art at the time of applicant's invention to combine the disclosures of Dunn and Hawkins with that of Harris in order to develop an efficient automated system for reconciling account records.

5.   **Claims 21 and 23 are rejected** under 35 U.S.C. 103(a) as being unpatentable over Dunn in view of Hawkins, and further in view of Josephson (US Patent 5,689,579). The disclosures of Dunn and Hawkins are cited above.

Dunn and Hawkins do not disclose

- **Re. Claim 21,** the method of claim 16, wherein predefining the matching rules further comprises predefining matching criteria in terms of a tolerance in at least one of percentage terms and nominal terms;

- **Re. Claim 23,** the method of claim 16, wherein predefining the matching rules further comprises predefining the matching rules in terms of levels of match success.

- However, Josephson discloses a

- **Re. Claim 21,** the method of claim 16, wherein predefining the matching rules further comprises predefining matching criteria in terms of a tolerance in at least one of percentage terms and nominal terms (Abstract; Col. 4, lines 9 – 66);

- **Re. Claim 23,** the method of claim 16, wherein predefining the matching rules further comprises predefining the matching rules in terms of levels of match success (Col. 4, lines 45-50).

It would have been obvious for an ordinary practitioner of the art at the time of applicant's invention to combine the disclosures of Dunn and Hawkins with that of Josephson in order to develop an efficient automated system for reconciling account records.

Conclusion

7.   Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Siegfried Chencinski whose telephone number is 703-305-6199. The Examiner can normally be reached Monday through Friday, 9am to 6pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Hyung S. Sough, can be reached on 703-308-0505.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 308-1113.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington D.C. 20231

or faxed to:

(703)305-7687   [Official communications; including
                          After Final communications labeled
                          "Box AF"]

(703) 746-8177   [Informal/Draft communications, labeled
                          "PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th floor receptionist.

SEC

March 28, 2003

HYUNG SOUGH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600